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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,713	08/06/2001	Takayuki Usui	Q65607	8286

7590

07/01/2005

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,713

Applicant(s)

USUI ET AL.

Examiner

Jila M. Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 11, 27, 30 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) 35-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 11, 27, 30, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 06, 2005 has been entered.

Election/Restrictions

2. Newly submitted claims 35-37 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: They are directed to a non-elected species.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 35-37 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8, 11, 27, 30 and 33-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which applicant regards as the invention. In claims 8, 30 and 33, the phrase "said light-shielding member being circumferentially larger than said box main body such that said light-shielding member surrounds and covers an outermost portion of said box main body" is vague and indefinite. It appears that the light-shielding member is an upper surface of the walls of the box main body and is actually a part of the box main body and it actually surrounding an opening in the box main body. The light-shielding member is circumferentially larger than said box main body opening and not the box main body.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 8, 27, 30 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Kudo (4,992,815). Kudo `815 discloses a printing plate packaging box comprising: a box main body (13) which accommodates a bundle of photosensitive printing plates (11), which are not sealed within a light-shielding wrapper (see Figure 4 embodiment) and which is provided with a supply opening through which the photosensitive printing plates are taken out; an opening/closing lid (12) which is removably attached to said box for opening/closing the supply opening; and a light shielding member (groove portion (13b) and circumferential peripheral edge of lid (14), (see Figure 4 embodiment and column 2, lines 34-38) which prevents direct entry of light from outside into the inside of

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the box main body, provided in the vicinity of a zone in which the box main body and the opening/closing lid are connected to each other in an assembled state, the light-shielding member (circumferential peripheral edge) being connected to the opening/closing lid such that the light-shielding member blocks the direct entry of light from outside into the inside of the box through the zone in which the box main body and the opening/closing lid are connected to each other in the assembled state.

The lid (14) of Kudo '815 is removably attached to the said box inasmuch as it can be separated and detached from the box.

The photosensitive printing plates will be in direct contact with said main body as modified above.

The light-shielding member of Kudo '815 is circumferentially larger than said box main body opening and surrounds and covers an outermost portion of the main body opening.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8, 27, 30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo (4,992,815). Kudo '815 discloses a printing plate packaging box comprising: a box main body (13) which accommodates a bundle of photosensitive printing plates (11) and which is provided with a supply opening through which the

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photosensitive printing plates are taken out; an opening/closing lid (12) which is removably attached to said box for opening/closing the supply opening; and a light shielding member (groove portion (13b) and circumferential peripheral edge of lid (14), see Figure 1 embodiment and column 2, lines 34-38) which prevents direct entry of light from outside into the inside of the box main body, provided in the vicinity of a zone in which the box main body and the opening/closing lid are connected to each other in an assembled state, the light-shielding member (circumferential peripheral edge) being connected to the opening/closing lid such that the light-shielding member blocks the direct entry of light from outside into the inside of the box through the zone in which the box main body and the opening/closing lid are connected to each other in the assembled state.

It would have been obvious to one of ordinary skill in the art at the time the invention was made not to wrap the bundle of photosensitive printing plates in a light shielding wrap, since it has been held that omission of an element and its function in combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184. The printing plate packaging box of Kudo '815 prevents direct entry of light from outside into the inside of the box irrespective of the light shielding wrap.

If there is any doubt that the lid of Kudo '825 can be detached from the box, it would have been obvious to make the lid and box of Kudo'815 separate and distinct from each other since it has been held that constructing a formerly integral structure in

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various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

The photosensitive printing plates will be in direct contact with said main body as modified above.

The light-shielding member of Kudo '815 is circumferentially larger than said box main body opening and surrounds and covers an outermost portion of the main body opening.

9. Claims 8, 27, 30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dirx (5,893,002). Dirx '002 discloses a printing plate packaging box comprising: a box main body (20) which accommodates a bundle of photosensitive printing plates (27) and which is provided with a supply opening through which the photosensitive printing plates are taken out; an opening/closing lid (42) which is removably attached to said box for opening/closing the supply opening; and a light shielding member (frame 41, see column 4, lines 38-40) which prevents direct entry of light from outside into the inside of the box main body, provided in the vicinity of a zone in which the box main body and the opening/closing lid are connected to each other in an assembled state, the light-shielding member being connected to the opening/closing lid such that the light-shielding member blocks the direct entry of light from outside into the inside of the box through the zone in which the box main body and the opening/closing lid are connected to each other in the assembled state. See Figures (5 and 10 embodiments).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made not to wrap the bundle of photosensitive printing plates in a light shielding wrap, since it has been held that omission of an element and its function in combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184. The printing plate packaging box of Dirx '002 prevents direct entry of light from outside into the inside of the box irrespective of the light shielding wrap.

The photosensitive printing plates will be in direct contact with said main body as modified above.

The light-shielding member of Dirx '002 is circumferentially larger than said box main body opening and surrounds and covers an outermost portion of the main body opening.

10. Claims 11 and 34 are rejected under 35 U.S.C. 103(a) as being obvious over either of Kudo '815 or Dirx '002 in view of Lermer (5,495,944). Each of Kudo '815 or Dirx '002 as described above disclose all the limitations of the claim except for a smooth sheet-type material adhered to the outer surface of the packaging. Lermer '944 discloses that it is old and conventional to adhere a sheet-type material of which surface is smooth and airtight to the outer surface of a packaging in order to make it air tight (see column 1, lines 27-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adhere a sheet-type material of which surface is smooth to the outer surface of the packaging of Kudo '815 or Dirx '002

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as taught by Lermer '944 in order to make the packaging air tight and prevent the contents from damage.

Response to Arguments

11. Applicant's arguments filed March 22, 2004 have been fully considered but they are not persuasive.

The packaging box of Kudo '815 and/or Dirx '002 will prevent direct entry of light from outside into the inside of the box main body regardless of having an additional internal wrapper or not.

With respect to the environment in which the claimed printing plate packaging box is used, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Contrary to applicant's argument the lid (14) of Kudo '815 is removably attached to the said box inasmuch as it can be separated and detached from the box.

Contrary to applicant's arguments, the light-shielding member of Dirx '002 and/or Kudo '815 are circumferentially larger than said box main body opening and surrounds and cover an outermost portion of the main body opening.

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Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JILA M. MOHANDESI
PRIMARY EXAMINER**



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
June 29, 2005